

REMARKS

Claims 1-66 are pending, with claims 1, 27, 48 and 49 being independent. Claims 1 and 49-66 have been amended. Claims 67-71 have been added. The specification fully supports the claim amendment. (See, Applicant's specification at 18:12-14; 20:20 – 21:2; 39: 9-12)

Rejections under 35 U.S.C. § 101

Claims 49-66 stand rejected under 35 U.S.C. 101 for allegedly being directed toward non-statutory subject matter. While not agreeing with the rejection, claims 49-67 have been amended to obviate the rejections and expedite the prosecution of the present application.

Amended claim 49 is provided below for convenience.

Claim 49. **A computer-readable medium embodying computer software** for encouraging users of a computer network to access a dynamic pricing system, the software comprising instructions to cause a computer system to perform operations comprising:

present a user-interface that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network and displays an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive resource providing an incentive, independent of the dynamic pricing information, to use the modular computer program, wherein the interactive visual indication of the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the user-interface; and

transfer information selected by a first user for display to a second user.

(Emphasis added.)

Amended claim 49 recites a computer software embodied on a computer-readable medium, which defines structural interrelationships between the computer software and the tangible medium. Also, the instructions included in the computer software of claim 49 provide a practical application of causing a computer system to perform operations including presenting a user-interface and transferring information. Thus, claim 49 is clearly directed to statutory subject matter. (See MPEP 2106.01(I).)

The Office contends that the claimed “tangible medium” is non-statutory because the Applicant explicitly defines “tangible medium” as being “...a high speed backbone that may support point-to-multipoint transmission....” (See Examiner’s Answer Dated August 20, 2007 at 11.) While not agreeing with the rejections, claims have been amended to obviate the rejections. In addition, Applicant’s specification discloses the high speed backbone as covering only one of many embodiments. For example, in some implementations, the “navlets” are used as application programs independent of web browsers. These navlets and the data retrieved by the navlets can be stored at storage locations and servers (i.e., hardware). (See e.g., Applicant’s Specification at 18:12-14; 20:20 – 21:2.)

“Programming of the navigation aid or navlet may be accomplished by loading a register or storage location with a URL of the next point in the taxonomy to place the navlet into the taxonomy.”

(See *id.* at 18:12-14. Emphasis added.)

“The navlet instance 600 may provide an undock control 618 to provide an ability to quickly undock the navigational instance or navlet from a participating web site to create a stand alone frame or application of the navigational instance that is separate from the web site or browser application. In the un-docked mode, the navigational dynamic instance or navlet may exist without a browser application or within an appropriately sized browser frame while maintaining contact with a server that may provide dynamic content for the navigational dynamic instance or navlet.

(See Applicant’s Specification at 20:20 – 21:2.)

Thus, the specification supports various tangible computer-readable medium and hardware such as storage locations and servers. Further, the original claims are part of the original disclosure and must be accorded full weight. (See, MPEP §608.01(I).) The original claim 49 recites a tangible medium, which is well known in the art, and one of ordinary skill in the art would understand the scope of the claimed “tangible medium.”

Therefore, independent claim 49 and its dependent claims 50-66 clearly are directed to statutory subject matter as defined in MPEP 2106(I).

Rejections under 35 U.S.C. § 103(a)

Claims 1, 3-5, 10-27, 29-49 and 51-66 stand rejected under 35 U.S.C. 103(a) as allegedly being obvious over the combination of Wagoner and Montero et al. While Applicant disagrees with the rejections, claim 1 has been amended to expedite the prosecution of the present application.

The Office contends that claim 1 does not require the first user to actively select information and send the selected information to the second user. (See, Examiner's Answer Dated August 20, 2007 at 14.)

The Examiner notes, the language of claim 1 merely requires a first user to select certain information to receive, followed by a circumstance wherein the same information could be separately communicated to a second user. However, the claims do not require the first user to actively select information and send said selected information to the second party. There is no required relationship pertaining to the data and the first user set forth in the claims.

(See *id.*)

While Applicant disagrees, claim 1 has been amended to recite in part, “**enabling the first user to communicate** the dynamic pricing information **selected by the first user to a second user** selectively designated by the first user for display at a modular computer program, executing on a computer system associated with the second user, that displays to the second user a stream of dynamic pricing **information selected by the first user.**” (Emphasis added.) Thus, claim 1 expressly requires enabling the first user to “communicate the dynamic pricing information selected by the first user to a second user.” Applicant's specification provides some examples.

“In another mode, the system may display a candidate advertisement form to the system 1516 to a predetermined administrative user of the system or to general user as a way to collect user profile information and as a way for users to place advertisements, distribute coupons or propagate game pieces.”

(See Applicant's Specification at 39: 21-24.)

“In another mode of the system, the bid control may provide a web page for a participant to place a bid whereby the system may post the bid in a bulletin board format and make the information available to further system participants.”

(See Applicant's Specification at 19:22-24.)

“In another mode, the navlet may provide an application layer frame, whose description below is hereby incorporated by reference, to encode a bid with taxonomic or subject matter information that may be subsequently routed to subscribers.)

(See Applicant's Specification at 19:24-20:3.)

In contrast, as conceded by the Office, Wagoner fails to disclose or suggest whether the auction data displayed on the vehicle dealer terminal includes *enabling the first user to communicate dynamic pricing information selected by the first user to the second user* as recited in claim 1. (See Examiner's Answer Dated August 20, 2007 at 13-14.) Wagoner simply discloses an alternate remote location for viewing the auction data, and being able to view the auction data at a remote location discloses nothing about a relationship between the data and the first user. (See, Wagoner at ¶¶ [0101]-[0103].) Thus, as conceded by the Office, Wagoner merely teaches displaying information to first and second users. (See *id.*)

The addition of Montero fails to alleviate the deficiencies of Wagoner. Montero teaches “an apparatus and technique for delivering information to subscribers on a communication network such that the information and the subscriber's selected data is simultaneously viewable by the subscriber.” (Montero at Col. 2, ll. 56-60.) In Montero, information sent to the subscribers are obtained from multiple INFO servers 120, which “continuously transmit information, such as advertisements,..., to form a sequence of information.” (*Id.* at Col. 4, ll. 63-66.) While Montero provides information, such as advertisements, to the subscribers, Montero, similar to Wagoner, is silent as to whether the claimed *dynamic pricing information is selected by the first user* and whether this *dynamic pricing information selected by the first user is communicated to a second user for display at a modular computer program* as recited in claim 1. In fact, the Office concedes that the proposed combination does not teach or suggest these features. (See Examiner's Answer Dated August 20, 2007 at 13-14.)

Also, the Office contends that “Montero discloses a method wherein INFO servers continuously transmit information such as advertisements, news, messages, web pages, data packets, stock tickers, announcements, updates and like, to form a sequence of information (Montero: column 4, line 63 to column 5, line 12).” (See, Examiner's Answer Dated August 20, 2007 at 14.) From this, the Office concludes that “[t]his sequence of information is transmitted

together and continuously (i.e., mutually embedded)." (See *id.*) However, the cited portions fail to support this contention. Montero does not disclose "visually embedding" the "user-attractive resource within the stream of dynamic pricing information" as recited in claim 1. The Office is merely proffering a guess unsupported by factual evidence. The Office has failed to explain why it is reasonable to assume that merely having the sequence of information transmitted together in Montero is equivalent to the claimed "the interactive visual indication of the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the modular computer program" as recited in claim 1. Applicant respectfully submits that it is not the same.

While Montero provides information, such as advertisements to the subscribers, Montero is silent as to whether the information in Montero is ***visually embedded within the stream of dynamic pricing information***, as recited in claim 1. Even if, *arguendo*, the information displayed in Montero could reasonably be construed as the claimed ***user-attractive resource***, Montero would still fail to teach or suggest that the information is ***visually embedded within the stream of dynamic pricing information***, as recited in claim 1.

Therefore, even if, *arguendo*, the alleged dynamic pricing information in Wagoner could somehow be combined with the information in Montero, the hypothetical combination of Wagoner and Montero would still fail to teach or suggest each and every feature of claim 1, for example, the claimed ***user-attractive resource which is visually embedded within the stream of dynamic pricing information displayed by the modular computer program***. Further, both Wagoner and Montero fail to teach or suggest a desirability to embed information in Montero within the alleged stream of dynamic pricing information in Wagoner.

For at least these reasons, claim 1 is patentable over the proposed combination of Wagoner and Montero.

As a separate and independent reason why the obviousness rejections of claim 1 is improper, the Office has failed to identify and articulate a legally proper basis for combining Wagoner with Montero.

A determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed inventions, as the Office has attempted to do in the Office Action dated November 1, 2006 and in the Examiner's Answer dated August 20, 2007. In this case, the alleged motivation as cited by the

Office makes use of impermissible hindsight reconstruction. The Office has reviewed the present application, selected a prior art system relating to a vehicle auction, namely Wagoner, and then searched other prior art for the missing elements without identifying or discussing any specific evidence of motivation to combine, other than providing conclusory statements regarding the knowledge in the art, motivation and obviousness. Such an attempt to merely piece together each claim element from various independent teachings is not evidence to support the legal conclusion of obviousness.

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

See KSR Int'l Co. v. Teleflex Inc., slip op. at 14-15. (Emphasis added.)

Common sense and judgment can only lead one to conclude that the Office's conclusion on obviousness is based on impermissible hindsight gleaned entirely from Appellants' disclosure. Although, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning" the Office is permitted to use "only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from appellant's disclosure" (*See*, MPEP §2145, X, A.) In fact, this is the type of impermissible hindsight that the Supreme Court warned against in *KSR*.

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. *See Graham*, 383 U. S., at 36 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.

See KSR Int'l Co. v. Teleflex Inc., slip op. at 18 (emphasis added).

For at least these additional reasons, claim 1 is patentable over the proposed combination of Wagoner and Montero.

Independent Claims 27, 48, and 49

Independent claims 27, 48 and 49 are allowable over the proposed combination of Wagoner and Montero for at least the reasons set forth with respect to claim 1 above. In particular, claim 27 recites “a modular computer program comprising instructions to perform the following operations: receive from the first user information identifying a selection of the received dynamic pricing information; send the received selection information from the first user to a second user; and present to the second user of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network that was selected by the first user and sent to the second user...” Thus, the claimed modular computer program enables “receiv[ing] from the first user information identifying a selection of the received dynamic pricing information “and having the information selected by the first user to be “sent to the second user.” This requires more than merely displaying information to the first user and displaying the same information to the second user as disclosed in Wagoner and Montero. Independent claims 48 and 49 recite similar features.

For at least these reasons, independent claims 27, 48 and 49 are allowable over the proposed combination of Wagoner and Montero.

Dependent Claims 3-5, 10-26, 29-47, and 51-56

Dependent claims 3-5, 10-26, 29-47, and 51-56 depend from claims 1, 27 and 49, and are allowable over the proposed combination of Wagoner and Montero for at least the same reasons.

Dependent Claims 2, 6-9, 28 and 50

Claims 2, 6-9, 28 and 50 stand rejected under 35 U.S.C. § 103(a) based on the proposed combination of Wagoner, Montero and Bowman. The rejections and their underlying reasoning are respectfully traversed.

Claims 2, 6-9, 28 and 50 depend from claims 1, 27 and 49, and are allowable over the proposed combination of Wagoner and Montero for at least the same reasons. The addition of Bowman fails to alleviate the deficiencies of Wagoner and Montero.

Bowman is directed to a system and method “for interacting with a user over a network for personalizing a website.” (*See* Bowman at Abstract.) In addition, Bowman discloses using Java to “create robust User Interface (UI) components.” (*See id.* at Col. 10, ll. 12-21.) However, Bowman suffers from the same deficiencies as Wagoner and Montero with respect to the claimed

elements of independent claims 1, 27 and 49. Merely disclosing the use of Java programming is not sufficient to teach or suggest each and every feature of independent claims 1, 27 and 49. For example, Bowman fails to disclose or suggest the claimed Applet ***computer program*** capable of ***receiving dynamic pricing information, displaying the received dynamic pricing information, receiving from the first user information, sending the received selection information, and presenting to the second user*** as recited in claims 1-2, 27-28 and 49-50.

The Office contends that Applicant is merely attacking the references individually and not the proposed combination. (See Examiner's Answer Dated August 20, 2007 at 15.) Applicant disagrees. As stated above, Bowman is shown to suffer from the same deficiencies as Wagoner and Montero. Specifically, Bowman also fails to disclose or suggest "enabling the first user to communicate" information selected by the first user "to the second user." In addition, the Office concedes that Wagoner and Montero fails to teach these features. Thus, even if Wagoner, Montero and Bowman could some how be combined (which is not conceded), the hypothetical combination still would fail to teach each and every feature of claim 2, 6-9, 28 and 50, which depend from claims 1, 27, 49.

For at least these reasons, claim 2, 6-9, 28 and 50 are allowable over the proposed combination of Wagoner, Montero and Bowman.

New Claims 67-71

Newly added claims 67-71 are allowable over the cited prior art for at least the same reasons as the independent claims 1, 27, 48 and 49. In addition, claims 67-71 are allowable for independent reasons. In particular the cited prior art fails to teach or suggest the claimed "receiving from the first user, an expiration date associated with the dynamic pricing information."

Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as intent to concede any issue with regard to any claim, except as specifically stated in this paper.

For the foregoing reasons, all pending claims are in condition for allowance, and a notice to that effect is requested.

Please apply the Request for Continued Examination fee and excess claim fees and any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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